

If the search and examination of an entire application can be made without a serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Searching this application presents no serious burden. All of the sequences claimed are derived from transcription factors. Additionally, all the transcription factors are derived from plants. The sequences recited in the claims are related. The groups within the Markush groups of the claims share a structural feature and a common utility. For at least these reasons, the claims reciting them can be examined and searched together. The Patent Office has failed to show that a burden exists in examining all the claims together, and thus, under M.P.E.P. § 803, the claims must be examined together. For these reasons, applicants request reconsideration.

In addition, it would seem that a search of Group I would encompass at least the results of a search for Groups III and IV. Each of these groups includes an isolated or recombinant polypeptide or the polynucleotide that encodes that polypeptide. The search will necessarily encompass all of that subject matter. Each of Groups I and IV also encompass plants. The polypeptide of Groups III and IV and the polynucleotide of Group I share a common utility and share a structural feature in that the polynucleotide encodes the polypeptide. Therefore, applicants respectfully request that, should the restriction requirement be maintained, Groups I, III and IV be joined.

Furthermore, the Patent Office insists that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another (*see* page 11 of Paper No. 7). Without considering the merits of such a statement, applicants submit that the Patent Office's own rules for examination practice indicate that a burden in examining multiple nucleotide sequences does not exist. At M.P.E.P. § 803.04, the following text appears:

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be

independent and distinct inventions and will continue to be examined together.

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three-dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten.

These rules clearly show and direct that at least ten different sequences can be and should be examined together. Thus, according to the Patent Office, there is no burden in searching at least ten different sequences. Any reasoning suggesting that restriction and election of a single sequence is proper cannot be sustained. In the face of this clear indication that at least ten sequences should be examined together, the Patent Office has not shown why there is a burden in searching all the claims here. None of the reasons given for the restriction requirement or the election of species requirement implicate a serious burden.

Furthermore, the Patent Office has not addressed or provided any evidence or reasoning on the applicability of the "exceptional case" here. As noted in the rule quoted above, certain complexity requirements must be met for cases where the ten nucleotide examination rule is not employed. The Patent Office has not asserted that this case is exceptional or provided any evidence that it might be. Thus, applicants submit that the above-quoted rule applies to this application and the Patent Office should apply it properly.

No extension of time fees or requests for extension of time, or any other fees or petitions, are believed to be necessary to enter and consider this paper. If, however, any petitions or extensions of time are required or any fees are due in order to enter or consider this paper or enter or consider any paper accompanying this paper, including fees for net addition of claims, or in order to keep this application pending, applicants hereby request any extensions or petitions necessary and the Commissioner is hereby authorized to charge Deposit Account No. 50-1129 for any fees.

Respectfully submitted,
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